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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/657,749	05/30/1996	JAMES G. METZ	CGNE-101-2	2351
7590	11/19/2003		EXAMINER	
ARNOLD & PORTER			KALLIS, RUSSELL	
ATTN: IP DOCKETING DEPARTMENT				
555 TWELVE STREET N.W.			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20004-1206			1638	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	08/657,749	METZ ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Russell Kallis	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 August 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3, 11-13 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3, 11-13 and 29-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 1-3, 11-13 and 29-33 are pending.

Rejections under 35 U.S.C. 112, first paragraph are withdrawn in view of Applicant's amendments.

Applicant's asserts priority to USSN 08/066299 that issued as U.S. Patent 5,445,947 because the application USSN 08/066299 allegedly describes the jojoba  $\beta$ -ketoacyl-CoA synthase cDNA sequences of the instant application. However, the identity and function of the jojoba clones described in figures 2 and 3 of USSN 08/066299 were not known. Further, there is no support in the USSN 08/066299 application for the methods of the instant claims, namely methods of increasing or altering very long fatty acid molecules using a cDNA encoding a jojoba  $\beta$ -ketoacyl-CoA synthase. The instant application is drawn to a polynucleotide encoding a polypeptide having a  $\beta$ -ketoacyl-CoA synthase activity, which was first disclosed in parent application 08/265,047 filed 06/23/1994 now issued U.S. Patent 5,679,881. Accordingly, the effective filing date of the instantly claimed invention is 23 June 1994.

### ***Double Patenting***

Claims 1-3, 11-13, and 29 remain and newly added Claims 30-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-3 of U.S. Patent No. 5,679,881. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claim 2 of the issued patent the method is drawn to the production of VLCFA encompassing the method of Claim 1 and the method steps of Claim 29 of the instant application, thus teaching the method for altering the composition of fatty acids in a plant cell.

Applicant asserts that Applicant will submit a terminal disclaimer upon indication of allowable subject matter (response, page 19). However, a statement of intent does not overcome the rejection, and therefore the rejection is maintained.

Claims 1-3, 11-13, and 29-33 are deemed free of the prior art given the failure of the prior art to teach or suggest a method for the production or alteration of VLCFA in a plant seed cell or plant embryo cell.

No claim is allowed.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (703) 305-5417. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0198.

Russell Kallis Ph.D.  
November 13, 2003

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180 1638

